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Patent

In the United States Patent and Trademark Office
Board of Patent Appeals and Interferences

In the Application of:

Vladimir Grushin et al.

Case No.: PE0649 US DIV6

Application No.: 10/696,048

Group Art Unit: 2813

Filed: October 29, 2003

Confirmation No.: 5833

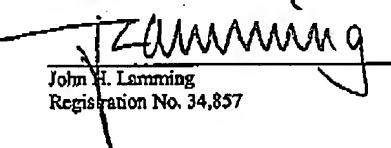
Examiner: Stephen W. Smoot

For: Electroluminescent Iridium Compounds with Fluorinated Phenylpyridines,
Phenylpyrimidines, and Phenylquinolines and Devices Made with Such Compounds

CERTIFICATE OF FACSIMILE TRANSMISSION

DATE: July 11, 2007

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Mail Stop Appeal Brief - Patents
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Reply Brief - 37 C.F.R. § 41.41

Responsive to the Examiner's Answer mailed on May 11, 2007, Appellant submits this
Reply Brief.

2. Related Appeals and Interferences

Appellant acknowledges that an appeal is pending in Application Serial No. 10/983,119,
and further states that Appellant's Brief, the Examiner's Answer, and a Reply Brief have been
filed in that matter..

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3. Status of Claims

Appellant acknowledges that claims 19-22 were not entered in this application, and call attention to Section 4, "Status of Amendments" in Appellant's Brief where that fact was presented.

10. Response to Argument

Claims 16-18 Are Non-Obvious Over Hamprecht In View of Forrest and Djurovich

The Examiner's Answer, in the paragraph bridging pages 6 and 7, states that the references in combination have all of the limitations of claims 16-18. In addition, the Examiner asserts that Hamprecht is analogous art (paragraph bridging pages 7 and 8) by characterizing the filed as "organic compounds that utilize phenypyridine ligands" (page 8, lines 6-7).

Claims 16-18 are directed to an electronic device comprising an organic layer comprising at least one Ir(III) compound made from precursor compounds having the structure shown (claim 16), the device in which the organic layer is a light-emitting layer (claim 17), and the device in which the organic layer is a charge transport layer (claim 18). Hamprecht teaches that certain molecular structures disclosed in that reference are useful as herbicides or herbicide intermediates. Appellant respectfully submits that the Examiner has characterized the field much too broadly with respect to claims 16-18, and has not explained adequately how Hamprecht addresses the same problem or an analogous problem as the present application, which might allow its cross-field application as a reference. This lack of explanation constitutes a short-fall on meeting the burden of going forward which is an essential part of a *prima facie* case of obviousness.

The Examiner has cited *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992) in support of a cross-field application of Hamprecht as a reference in this application. In *Oetiker*, the CAFC reversed the final rejection of all claims for obviousness in terms of 35 U.S.C. § 103. In that case, the Board had apparently determined that "all hooking problems are analogous" (24 USPQ2d at 1445, col. 2). Oetiker had invented an improvement to a metal hose clamp, and the art cited against the claims came from non-analogous fields, such as door latches and hook-and-eye type fasteners commonly used in the garment industry. After discussing the circumstances under which it may be proper to apply a cross-field reference to an application under examination, the Court held (at 1446, col. 1) that "[i]t has not been shown that a person of

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ordinary skill, seeking to solve the problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments." In the same text, the Court stated that "the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness." There has been no showing in this case why one inventing electronic device components would look to the herbicide arts. Failing to make a *prima facie* case simply means that the initial burden of going forward with substantial evidence of unpatentability has not been met.

Appellant respectfully disagrees with the Examiner's argument that Appellant's arguments on impermissible hindsight have not been presented properly. Appellant has, in fact, argued that knowledge used in the rejection of claims 16-18 was gleaned solely from Appellant's invention. An example of Appellant's arguments includes the following:

Page 4, line 13: "No claimed compound is found in any of the three cited references."

Appellant argues strenuously that the final rejection merely assembles elements of the claimed invention and finds references that appear to contain or suggest them. This is clearly the crux of the arguments presented in Appellant's Brief.

In addition, the Appellant has not impermissibly isolated the references and attacked them alone, but has, as is necessary and essential, discussed them individually to present the content and essence of each, as an essential prerequisite to discussing how they might, or how they actually fail, to combine to produce the claimed subject matter.

Appellant respectfully reasserts that Hamprecht is not analogous art, and that the only way these references can logically be combined to produce the subject matter of claims 16-18 is by hindsight reconstruction, or the related obvious-to-try principle, which have been criticized by the U.S. Court of Appeals for the Federal Circuit. *See Ex parte Obukowicz*, 27 USPQ2d 1063, 1065 (BPAI 1992) and authorities cited therein. For all of the foregoing reasons, Appellant respectfully requests that this rejection be reversed.

Claims 12-15 are patentable under 35 U.S.C. § 103(a) over Hamprecht, Forrest and Djurovich as applied to claims 16-18 and further in view of Dedeian

Appellant respectfully reiterates that claims 16-18, discussed above, are within the scope of claims 12-15, and thus all of the foregoing remarks presented in response apply here as well.

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On page 10 of the Answer, the various elements from the claims are recited and linked to the different references, four in all (Hamprecht, Forrest, Djurovich and Dedeian). Appellant pointed out in the Brief that Dedeian's complexes are not demonstrated to possess electroluminescence, and that the property of electroluminescence may not be inferred from photoluminescence. This assertion has not been answered, insofar as Appellant can ascertain. Rather, the elements are collected and tied to cited references without a showing of how the references, taken together, would produce substances useful in electrical devices.

The Answer also states that Hamprecht discloses the precursor ligand of claim 16 (page 8, middle paragraph, page 10, lines 8-9). The full relevance of this argument, in light of Appellant's responses herein, is not clear. Clarification would be appreciated, especially in light of the Answer's use of the term of art "anticipated," in view of the fact that the final rejection of the pending claims under 35 U.S.C. § 103(a) constitutes the subject of this appeal.

Appellant respectfully reasserts here, also, that the Office did not establish that the claimed subject matter is *prima facie* obvious.

Conclusion

For the foregoing reasons, the rejections of claims 12-15 and 16-18 should be reversed and vacated.

Respectfully submitted,


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